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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,193	12/12/2001	Mai Huong Dang	52200.8010	5901
22918	7590	01/03/2006	EXAMINER	
PERKINS COIE LLP			PADGETT, MARIANNE L	
P.O. BOX 2168			ART UNIT	
MENLO PARK, CA 94026			PAPER NUMBER	
			1762	
DATE MAILED: 01/03/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/017,193	Applicant(s) DANG ET AL.	
	Examiner Marianne L. Padgett	Art Unit 1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 11,16-19,27 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-10, 12-15, 20-26, 29-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Applicant's discussion of the meaning of "homofunctional" may be considered to provide file wrapper estoppel for the meaning of this term with respect molecules, and as its use in claim 31 depends from claim 29, which defines the multifunctional thinker as comprising at least one molecule, claim 31 can be considered to require pleural molecules so as to alternate homofunctional molecules as claimed.

2. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

While applicants' amendment removes the 112, second paragraph rejection for claim 7 they did not cite any support for the basis of calculating the claimed carrier gas percentages by volume. While the examiner review of the specification for such support she only found disclosures on pages 4 & nine for such gas percentages that did not provide any basis for how they were calculated, thus did not provide support for "by volume", hence lacking a showing of support it must be considered New Matter.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

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claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-9, 21-26 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ikada et al (4,743,258), as discussed in section 8 of the 7/18/2003 action, and section 7 of the 4/15/2004 action; in view of Yializis et al (6,118,218) or Krause et al (5,500,257), is discussed in section 5 of 4/29/2005 rejection.

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5. Claims 1-2, 5, 7, 25-26 and 29-30 (31) are rejected under 35 U.S.C. 103(a) as being unpatentable over Gudimenko et al (2003/0021996 A1), in view of Yializis et al , discussed in sections 5-6 of the 4/29/2005 rejection.

6. Claims 1-2, 5-7 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien (6,709,718 B2), in view of Yializis et al, or visa versa, as discussed in section 7 of the 4/29/2005 rejection.

7. Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Kunz et al (6,733,847 B2), as discussed in section 8 of the 4/29/2005 rejection.

Claims 7 & 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kunz et al, as discussed in section 8 of the 4/29/2005 rejection.

8. Claims 1-10, 12, 21-23, 26 and 29-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 and 11-17 of U.S. Patent No. 6,159,531 (Dang et al), in view of Yializis et al, and further in view of Ikeda et al (258) in claims 3-6, as discussed in section 10 (& 9) of the 4/29/2005 rejection.

9. Claims 13-15 and 20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 & 11-17 of U.S. Patent No. 6,159,531 in view of Yializis et al, in view of Ikada et al ('258), as applied above in section 10, and further in view of Valentini (6,428,579 B1) or Clapper (5,744,515), discussed in sections 6 & 11 of the action mailed 7/18/2003 & 4/29/05.

10. Claims 1-5, 7-10, 12, 20-24, 26 and 29-30 (31) are rejected under 35 U.S.C. 103(a) as being unpatentable over Subramanian (5,643,580) in view of Yializis et al, as discussed in section 12 of the 4/29/2005 rejection.

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11. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Subramanian ('580) in view of Yializis et al as applied to claims 1-5, 7-10, 12, 20-24 and 29-31 above, and further in view of Valentini or Clapper, as discussed in section 13 of the 4/29/2005 rejection.

13. Applicant's arguments filed 9/29/2005 & partially discussed above have been fully considered but they are not persuasive.

Applicants present arguments against applied references based on stability of functional groups, however as their functional groups are capable of reacting and are required to react in subsequent reactions, the references are considered to encompass stability within the scope of the claims unless the claims further define what their intent or scope for stability is such that they would exclude applied references.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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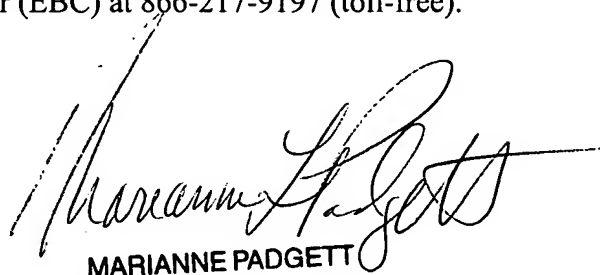
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne L. Padgett whose telephone number is (571) 272-1425.

The examiner can normally be reached on M-F from about 8:30 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks, can be reached at (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MLP 12/27/2005



MARIANNE PADGETT
PRIMARY EXAMINER